

## **REMARKS/ARGUMENTS**

### **Status of Application**

The present application is a continuation of U.S. Serial No. 09/790,231 filed in the Patent Office on February 21, 2001 (the "parent application").

In the above amendments, a number of amendments have been made to the specification, claims 1-77 have been cancelled without prejudice to their further prosecution, and claims 78-132 have been added to further claim the subject matter of applicants' disclosure.

### **Amendments to the Specification**

The specification has been amended to add references to the patent applications from which the present application claims priority under 35 U.S.C. § 120.

The original "Summary of the Invention" section of the specification has been replaced with a new summary section that is consistent with the new claims pursuant to 37 C.F.R. § 1.73, which states that "Such summary should, when set forth, be commensurate with the invention as claimed..." The five paragraphs that were added following the heading "Summary of the Invention" section on page 1 of the application are consistent with the new claims. Applicant submits that this is in keeping with 37 C.F.R. §1.73, which states that the "summary should, when set forth, be commensurate with the invention as claimed . . ." It is respectfully submitted that the new paragraphs do not constitute new matter.

### **General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term

---

<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

"invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence "As used herein, the term '\_\_\_\_\_' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In *re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement."). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. *Vas-Cath Inc. v. Mahurkar*, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) ("These cases support our holding that, under proper circumstances, drawings alone may provide a 'written description' of an invention as required by §112").

If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Dated: November 25, 2003

: Respectfully submitted,

By 

Aaron M. Peters

Registration No.: 48,801

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant